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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/711,692 | 11/13/2000 | Edward F. Tokas | 031221-057 | 8214 |

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EXAMINER

KNABLE, GEOFFREY L

ART UNIT PAPER NUMBER

1733

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------|------------------------------|--|
| Office Action Summary | Application No. 09/711,692 | Applicant(s) TOKAS ET AL. | |
| | Examiner Geoffrey L. Knable | Art Unit 1733 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004 and 23 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-43, 45-49, 95, 97 and 99 is/are pending in the application.
- 4a) Of the above claim(s) 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-18, 20-43, 45-49, 95, 97 and 99 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Claim 1 is generic to both species A1 and A2 and is substantively allowable subject to correction of 35 USC 112 rejections to follow. Accordingly, the restriction requirement as to the encompassed species is hereby withdrawn and claims 6, 12, 45-48 and 99, directed to the non-elected species A2 are no longer withdrawn from consideration since all of the claims to this species depend from or otherwise include each of the limitations of an allowed generic claim. However, claim 19, directed to the species "B2," remains withdrawn from consideration since claim 1 as amended is no longer considered to be generic to this embodiment and thus does not depend upon or otherwise include all the limitations of an allowed generic claim as required by 37 CFR 1.141.

In view of the above noted withdrawal of the restriction requirement as to the linked species, applicant(s) are advised that if any claim(s) depending from or including all the limitations of the allowable generic linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

2. Claims 1-9, 11-18, 20-43, 45-49, 95, 97 and 99 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 defines "applying a catalyst onto the first substrate surface". However, claim 1 as amended, now defines that the catalyst is diluted in a liquid carrier containing water" – this has been read to necessarily require "applying" the catalyst to the surface (i.e. in aqueous form) as defined in claim 13 and thus it is not seen that claim 13 further limits claim 1, the retaining of claim 13 with the amendments to claim 1 therefore raising a significant ambiguity in the scope of the claims including claim 1. It would be clearer if claim 1 were simply amended to specifically and unambiguously use the claim 13 "applying" language, it again being stressed that this is the only reasonable reading of the claim. If this is not what is intended, then the scope of claim 1 is entirely indefinite and confusing in referring to the catalyst being diluted in a liquid carrier but not implicitly requiring that the catalyst be applied in this form. In fact, if claim 1 is not to be read as requiring that the catalyst be "applied" with this carrier, then significant new matter issues would be raised as well. These however have not been made at this point as again it is considered to be an unreasonable reading of claim 1 that it does not require that the catalyst be "applied" in the noted form but again clarification is required. To repeat, additionally putting the claim 13 language explicitly into claim 1 would avoid this ambiguity.

Claim 14 likewise defines a feature that is now already considered to be included in claim 1 as amended and thus it is not seen how this claim further limits.

Claim 16 is considered to be inconsistent with claim 1 as amended and therefore an ambiguity is created. It is suggested that claim 16 be cancelled (it further being

noted that this claim will not be listed in the listing of claims that would be allowable if amended to overcome the 112 rejection).

Claims 21, 42 and 45 define that step (c) occurs at room temperature. However, claims 1 and 20 as amended already define that the bonding occurs "at normal ambient conditions" and thus these claims do not seem to further limit the claims from which they depend. In particular, if this is not the same as "room temperature," then the scope of this reference to "normal ambient conditions" cannot be readily ascertained and is therefore indefinite.

In claim 39, the first part of the claim is now redundant to material already in claim 1 and thus removal thereof from claim 39 would avoid any potential ambiguity in this regard.

In claim 43, line 2, the reference to "a liquid carrier" raises an ambiguity as it is not clear whether this is the same liquid carrier now defined in claim 1 – it is suggested that "a liquid carrier" be changed to "the liquid carrier" to avoid this ambiguity.

Claims 99 and 48 conflict with claim 1 as amended in that they define that the catalyst can be applied to either the first or second substrate (or only the second substrate for claim 48) whereas claim 1 requires that the catalyst be applied to the *first* substrate.

The first two lines of claim 95 repeat language.

3. Claims 1-9, 11-15, 17, 18, 20-43, 45-49, 95, 97 and 99 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

These claims would be allowable for the reasons given by applicant in the remarks accompanying the 1-23-2004 amendment, it being additionally noted that in addition to not being specifically directed to the same chemistry as presently claimed, Lesser, Cole et al. and Kriebel are directed to catalyzed coating rather than bonding substrates together as now claimed.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 571-272-1220. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on 571-272-1156. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Geoffrey L. Knable
Primary Examiner
Art Unit 1733

G. Knable
November 28, 2004